

## **REMARKS**

Claims 10, 19, 29, 38, 48, and 57 have been canceled, and claims 1, 5, 7-9, 11, 17, 18, 20, 24, 26-28, 30, 36, 37, 39, 43, 45-47, 49, 55, and 56 have been amended. Claims 1-9, 11-18, 20-28, 30-37, 39-47, and 49-56 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Objection to the Specification:**

The Examiner objected to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. Office Action at 2. In particular, the Examiner asserts that the claimed “computer-accessible storage medium” lacks clear support in the specification. *Id.* at 2-3. Applicant respectfully traverses this objection and notes that paragraph [0061] of the specification reads in part as follows:

Generally speaking, a computer-accessible medium may include storage media or memory media such as magnetic or optical media, e.g., disk or CD-ROM included in some embodiments of computer system 20 as mass storage device 250. A computer-accessible medium may also include volatile or non-volatile media such as RAM (e.g. SDRAM, DDR SDRAM, RDRAM, SRAM, etc.), ROM, etc, that may be included in some embodiments of computer system 20 as memory 210. Further, a computer-accessible medium may include transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as network and/or a wireless link, which may be included in some embodiments of computer system 20 as network interface device 260.

Thus, according to the specification, a “computer-accessible medium” may include “storage media or memory media such as magnetic or optical media, e.g., disk or CD-ROM” and/or “volatile or non-volatile media such as RAM (e.g. SDRAM, DDR SDRAM, RDRAM, SRAM, etc.), ROM, etc.” Applicants note that all of the described types of “storage media or memory media” or “volatile or non-volatile [memory] media” are in fact storage media, in that they are capable of storing data. Numerous examples of such storage media are provided in the quoted portion of the specification and elsewhere.

While these examples are not exclusive or limiting, each is supportive of the term “storage medium.”

Although “computer-accessible storage medium” may be a broad term, Applicant submits that one of ordinary skill in the computer-related arts would find ample antecedent basis for the term in the specification. Applicant therefore respectfully requests that the objection to the specification be withdrawn.

**Provisional Double Patenting Rejection:**

The Office Action provisionally rejected claims 1, 20, 30, 39 and 49 under the judicially-created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 13, 15, 27-29, 41 and 42 of copending Application No. 10/670,550. Claim 11 was provisionally rejected over claims 1 and 14 of copending Application No. 10/670,550 in view of Chesnais et al. (U.S. Patent 7,272,622) (hereinafter Chesnais). Claims 1, 20, 30, 39 and 49 were provisionally rejected over claims 1, 9, 11, 19-21 and 29-30 of copending Application No. 10/670,549. Claim 11 was provisionally rejected over claims 1 and 10 of copending Application No. 10/670,549 in view of Chesnais. Applicant acknowledges the provisional rejections and will address them should they become non-provisional.

**Section 112, Second Paragraph, Rejection:**

The Office Action rejected claims 10-20, 29-38 and 48-57 under 35 U.S.C. § 112, second paragraph, as indefinite. Specifically, the Examiner refers to the language of claim 10 that reads “storing an instant messaging operation associated with a given presence state of [an] instant messenger, wherein said given presence state correspond to [a] given user; [and] detecting a transition to said given presence state subsequent to said storing,” and asserts that “[a]ccording to the claim an instant messaging operation associated with a given presence state is stored, and following the storing of the instant message operation, there is a transition to the same given presence state. It is unclear as

to how there can be a transition to the given presence state when the user is already associated with the given presence state.” Office Action at 9-10. Language similar to now-canceled claim 10 also appears in independent claim 11 and in certain other claims, and Applicant’s remarks below will be directed to claim 11.

Applicant respectfully traverses the rejection and submits that the Examiner has misread the language of claim 11. The Examiner’s question regarding “how there can be a transition” presumes that storing an instant messaging operation that is associated with a given presence state that corresponds to a given user entails that the given presence state is in fact the current presence state of the instant messenger at the time of the storing. But this is not the language of claim 11. Claim 11 states only that the given presence state be a presence state of an instant messenger, and that the given presence state correspond to an online given user. Such a correspondence does not require that the given user actually be presently in the given presence state; rather, it entails only that there exist some relationship of correspondence between the given presence state and the given user.

In rejecting claim 11, the Examiner quotes from paragraphs [0094] and [0102]-[0104] of the specification. By way of non-limiting example, Applicant refers to paragraph [0089] of the specification, which reads in pertinent part as follows:

Additionally, in one embodiment, certain instant messenger operations may be associated with certain presence states for a given user, such that when the given user’s presence state transitions to a new state, any instant messenger operations associated with the new state may be performed. For example, if a given user needs to perform a task before leaving on a particular day, an alert operation including a task reminder message may be scheduled for the particular day and associated with a “gone home” presence state. When the given user manually selects the “gone home” presence state, or alternatively when the user’s calendar-based schedule information causes the “gone home” presence state to be selected as described above, the associated alert operation may be processed and delivered to the given user.

While Applicant submits that the language of claim 11 is clear on its face, in order to further enhance its clarity, Applicant has amended claim 11 to recite “detecting a

transition of a current presence state of said instant messenger to said given presence state subsequent to said storing.” Applicant submits that this amendment merely clarifies and does not alter the scope of the amended claims. A similar argument applies to independent claims 30 and 49, which have been amended in a manner similar to claim 11. Applicant therefore submits that the language of the claims is not indefinite, and respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

### **Section 102(e) Rejection:**

The Office Action rejected claims 1-3, 9-15, 18-22, 28-34, 37-41, 47-53 and 56-57 under 35 U.S.C. § 102(e) as being anticipated by Chesnais. Applicant respectfully traverses this rejection and submits that the pending claims are not anticipated by Chesnais for at least the following reasons.

Regarding claim 11, Chesnais fails to teach or suggest a method comprising storing an instant messaging operation associated with a given presence state of an instant messenger, wherein the given presence state corresponds to an online given user; detecting a transition of a current presence state of the instant messenger to the given presence state subsequent to the storing; and performing the instant messaging operation in response to the detecting.

In rejecting claim 11, the Examiner refers to col. 4, line 66 – col. 5, line 6 of Chesnais as disclosing each of the claim limitations. Office Action at 12. However, both the cited portion and the remainder of Chesnais fail to do so. The cited portion of Chesnais refers to a user of a mobile phone establishing a “do not disturb profile” which, when active, causes inbound messages to be queued for later delivery or retrieval by the user. First, a mobile phone and its associated operations are not suggestive of instant messenger operations. Second, nothing in Chesnais suggests that an instant messaging operation is stored in association with a given instant messenger presence state, and that in response to detecting a transition of a current presence state of the instant messenger to

the given presence state, the stored operation is performed. In the example of Chesnais, it is messages that are stored, **and Chesnais does not indicate that these messages are in any way associated with an instant messenger presence state, or processed in response to transitions in presence state.**

In fact, while Chesnais does mention instant messenger presence state, the only operation Chesnais performs with respect to such presence state is to “relay” or “forward” such information “if [it] is provided by the IM service provider.” Chesnais at col. 25, lines 36-49. That is, to the extent that Chesnais supports the use of instant messenger presence state at all, it is only to pass along such information in a passive manner. Chesnais does not disclose that such information is in any way processed for the purpose of detecting a transition, or that operations are performed in response to detecting such a transition.

Similar arguments apply to independent claims 30 and 49, which recite features similar to those of claim 11. Therefore, Chesnais cannot be said to anticipate claims 1, 30, or 49.

For similar reasons to those given for claim 11, Chesnais fails to anticipate amended independent claims 1, 20, and 39. As amended, claim 1 recites in part: receiving an instant messaging operation directed to a given user; determining a current presence state of the instant messenger in response to receiving the instant messaging operation, wherein the current presence state corresponds to said given user; and in response to determining that the given presence state matches the current presence state, processing the instant messaging operation. As noted above, Chesnais operates as merely a conduit with respect to instant messenger presence state information; if such information is available, the system of Chesnais passes it along. Chesnais does not disclose that such presence state information is examined or processed, whether to compare current state information against received state information, to detect a transition, or otherwise. Therefore, Chesnais cannot be said to anticipate independent

claims 1, 20, or 39, which specifically recite such a comparison of instant messenger presence state information.

**Section 103(a) Rejections:**

The Office Action rejected claims 4, 16, 23, 35, 42 and 54 under 35 U.S.C. § 103(a) as being unpatentable over Chesnais in view of Cristofalo et al. (U.S. Publication 2002/0152117) [hereinafter Cristofalo], claims 5, 7, 8, 17, 24, 26, 27, 36, 43, 45, 46 and 55 as being unpatentable over Chesnais in view of Horvitz et al. (U.S. Publication 2004/0143636) [hereinafter Horvitz], and claims 6, 25 and 44 as being unpatentable over Chesnais and Horvitz in view of Beyda (U.S. Publication 2003/0229722) [hereinafter Beyda]. Applicant notes that these references fail to remedy the omissions of Chesnais noted above, and traverses these rejections for at least the reasons given above with respect to the independent claims.

In regard to all the rejections, Applicant submits that the rejections of various ones of the dependent claims are further unsupported by the cited references. However, as the rejections of the independent claims have been shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

## **CONCLUSION**

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69900/RCK.

Respectfully submitted,

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